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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,635	07/13/2001	Jacques Dubac	022701-941	1628

21839 7590 01/25/2005

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,635

Applicant(s)

DUBAC ET AL.

Examiner

J. Pasterczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This Office action is in response to the amendment filed 11/12/04 and refers to the first Office action mailed 5/11/04.

2. The disclosure is objected to because of the following informalities: the term "lacuna" is still used in various places without obvious meaning or purpose. Other typos and proofreading should be dealt with as well.

Appropriate correction is required.

3. The abstract of the disclosure is objected to because it should be rewritten to correspond more to the formal requirements of the claims outlined below. Correction is required. See MPEP § 608.01(b).

4. Claims 11-14 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, if M represents an at least trivalent element, then the coefficient on Y could not be 3-q, as it would mean M is only trivalent. In the third from last line "carrying" is more accurately termed --bonded to--, and it is not clear from the claim language whether R_x is monovalent or divalent, although the specification seems to suggest both, in which case it may be better to split this into either two claims or two formulae for clarity's sake. On the other hand, all the working examples suggest that R_x is part of a triflate anion, in which case R_x is exclusively monovalent. R_x should also be referred to as a hydrocarbyl radical since a carbon atom must be present.

In claim 12, l. 3, the Greek letter mu should be subscripted as well as defined with a value; in l. 5 the inserted "wherein M" should apparently be --wherein mu--. In the third line

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from the end change “anion of” to --anion or--, in the last line it is not clear what is meant by “carried by a perhalogenated atom”, and the sources of the mandatory SO_3 and R_x groups are not identified.

In claim 13, “ R_x ” should be -- R_x --, it should be described as --a hydrocarbyl radical in which the carbon bonded to the sulfonic group--, the phrase “other than the sulfonates . . . functional group” is confusingly worded, and in the last clause it is not clear what is meant by “within the 5 closed range”.

In claim 14, R_x again should be described as --a hydrocarbyl radical in which the carbon bonded to--.

In claims 17 and 18, it is not clear if the limits on the values of q are inclusive or exclusive.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 11-14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Singh, Kawada, Desmurs I, or Desmurs II as cited in and for the reasons of record given in paragraph 12 of the previous Office action.

7. Applicant's arguments filed 11/12/04 have been fully considered but they are not persuasive.

Applicants admit that it is well known that the number and nature of ligands on a metal center strongly influence the Lewis acidity of that metal. This is the heart of the examiner's argument. In addition applicants argue that the cost of the finished catalyst is a major factor arguing for using less than a full complement of triflate ligands bonded to the metal atoms. The

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desire to minimize cost is a conventional motivation to change chemical compositions; see *In re Clinton*, 188, USPQ 365, 367 (CCPA 1976) and *In re Thompson*, 192 USPQ 275, 277 (CCPA 1976).

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID SAMPLE
PRIMARY EXAMINER



J. Pasterczyk

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1/14/04